

## REMARKS

This communication is in response to the non-final Office Action issued May 24, 2004. The Examiner rejected claims 1-3, 20, and 21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicants regard as the invention. The Examiner rejected claims 17, 18, 20, 22, and 27 under 35 U.S.C. § 102 in view of U.S. Patent No. 5,713,801 to Aoyama (Aoyama). The Examiner rejected claims 1, 3-6, 9-16, and 23-25 under 35 U.S.C. § 103 in view of Aoyama modified by U.S. Patent No. 6,001,930 to Rajagopalan (Rajagopalan). The Examiner indicated that claims 2, 8, and 21 were allowable.

### Non-Addressed Claims

While claims 1-6 and 8-33 are pending in the application, the Examiner addressed only claims 1-6 and 8-28. Thus, claims 29-33 have not been rejected and have therefore been tacitly allowed.

### Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

On page 1 of the Office Action, the Examiner rejected claims 1-3, 20, and 21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicants regard as the invention. Specifically, the Examiner stated:

Claims 1 and 20 both contain the limitation “another synthetic resin.” The limitation is indefinite because it encompasses more than what is disclosed in regards to synthetic resins.

Office Action, at page 2.

The Applicants respectfully traverse the Examiner’s rejections. Neither of claims 1 and 20 contains the language cited by the Examiner. While each of these claims contains “another

synthetic rubber,” the application has contained claims with this language since filing without comment by the Examiner, and claims in this application containing this language have been allowed - twice - by the Examiner. Thus, the Applicants do not believe the Examiner meant to cite this language. Furthermore, the Examiner’s proffered reason for the rejections is unclear.

In view of the foregoing, the Examiner’s rejections under 35 U.S.C. § 112, second paragraph, of the claims are believed to be overcome.

#### Claim Rejections Under 35 U.S.C. § 102

On pages 2-3 of the Office Action, the Examiner rejected claims 17, 18, 20, 22, and 27 under 35 U.S.C. § 102 in view of Aoyama.

It is well settled that for a rejection of a claim under 35 U.S.C. § 102 to be proper, each and every element as set forth in the claim must be found in a single reference. See, for example, MPEP § 2131. For at least the reasons stated below, the Examiner’s rejections of the claims do not satisfy this burden.

Claim 17 has been amended to include the recitations of claim 19, which has been canceled. Claim 17 now requires the center to have a diameter from about 3.05 cm to 3.8 cm. In addressing this language in the rejection of claim 19, the Examiner stated:

In regards to claim 19, the center has a diameter from about 1.2 to 1.6 cm being that the outside diameter is 1.4 to 1.8 inches and the thickness of the wound layer is 0.01 to 0.10 inches (See Column 3, lines 11 through 15).

Office Action, at page 3.

The Examiner’s rejection is respectfully traversed. Initially, claim 19 required, as claim 17 now requires, that the center have a diameter from about 3.05 cm to 3.8 cm, not 1.2 to 1.6 cm.

Secondly, the section of the patent cited by the Examiner discusses the first embodiment of the golf ball, which is the three-piece ball shown in figure 1. Notably, this golf ball contains a

core 100, a wound layer 105, and a cover 110; there is no intermediate layer. The wound layer 105 has an inside diameter - which corresponds to the core diameter - between 1.30 and 1.80 inches (*i.e.*, between 3.3 and 4.6 cm). Col. 3, lines 11-13. The golf ball of the second embodiment, shown in figure 2, contains a core 115, an intermediate layer 120, a wound layer 125, and a cover 130. By simply comparing figures 1 and 2, it is readily seen that the core (115) of the second embodiment is smaller than the core (100) of the first embodiment. Therefore, the core dimensions of the first embodiment have no bearing on the core dimensions of the second embodiment, which is the embodiment relied upon by the Examiner, and the rejection is improper and must be withdrawn.

In view of the foregoing, the Examiner's rejections under 35 U.S.C. § 102 to the claims are believed to be overcome.

#### Claim Rejections Under 35 U.S.C. § 103

On pages 3-8 of the Office Action, the Examiner rejected claims 1, 3-6, 9-16, and 23-25 under 35 U.S.C. § 103 in view of Aoyama modified by Rajagopalan.

It is well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, each and every recitation of the claim must be present in the cited reference(s). See, for example, MPEP § 2143.03. It is also well settled that for a rejection of a claim under 35 U.S.C. § 103 to be proper, there must be some suggestion or motivation to modify a reference or combine reference teachings. See, for example, MPEP § 2143.01. When so modifying a reference, the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. See, for example, MPEP § 2143.01. The modification must support a reasonable expectation of success with some degree of predictability. See, for example, MPEP § 2143.02. Finally, the source of the suggestion or

motivation to modify a reference cannot be the Applicants' own disclosure. See, for example, MPEP § 2143. For at least the reasons stated below, the Examiner's rejections of the claims do not satisfy these burdens.

The section of Rajagopalan cited by the Examiner refers to a sulfonated and/or phosphonated TPE polymer used as the cover material. This material, however, is a thermoplastic. Thus, its substitution into the Aoyama golf ball, the propriety of which is questionable but not discussed here for purposes of brevity, means that the requirement that at least one of the cover or intermediate layer be formed of a component which comprises a thermoset material is not satisfied by the proffered combination. Thus not all of the claim recitations are present in the proffered combination, and the rejections of the claims are improper and must be withdrawn.

Further regarding claim 1, the claim has been amended to recite that the intermediate layer is of an ionomer material. Support for this recitation is seen, for example, at page 16 lines 7-25.

In view of the foregoing, the Examiner's rejections under 35 U.S.C. § 103 to the claims are believed to be overcome.

#### Allowable Subject Matter

On pages 8-9 of the Office Action, the Examiner indicated that claims 2, 8, and 21 were allowable. The Applicants appreciate the Examiner's indication of allowable subject matter.

Claim 8 has been amended to be in independent form.

#### Additional Fees

The Commissioner is hereby authorized to charge any insufficiency, including an \$86 fee for the additional of another independent claim, or credit any overpayment associated with this

application to Swidler Berlin Shereff Friedman, LLP Deposit Account No. 19-5127 (order no. 20002.0227).

Conclusion

Claims 1, 4, 8, and 17 have been amended, and claim 19 has been canceled. Thus, claims 1-6, 8-18, and 20-33 are pending in the application, and are believed to be in condition for allowance. In view of the foregoing, all of the Examiner's rejections of the claims are believed to be overcome. The Applicants respectfully request reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner feel further communication would help prosecution, the Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Sean P. O'Hanlon", with a stylized flourish at the end.

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Dated: August 24, 2004

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